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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/922,463

Applicant(s)

GOMES ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3-7, 9, and 12-20 are presented for examination. Claims 2, and 8-11 are cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2005 has been entered.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because third sheet of drawing (3/3) missing label fig 3. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply

to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The various steps receiving and storing bookmark address in the predetermined directory for serving the request of the mobile device are software constructs (software per se) performing various functionalities. These functionalities do not manipulate any hardware or tangible entity. Therefore, these software constructs are non statutory entities as detailed in MPEP 2106.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 6 and their dependent claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Written description required for the limitation "the network path bookmark information is stored in a browser application installed in the client computer". For examining purpose network path bookmark information is stored in the predetermined directory.

8. Claims 1 and 6 and their dependent claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. Written description required for the limitation "the network path bookmark information is stored in a browser application installed in the client computer". For examining purpose network path bookmark information is stored in the predetermined directory.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 6 and their dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recited "repeatedly receiving, at a server in a predetermined time interval via a first communication network, the network path bookmark information from the client, computer, wherein the network path bookmark information is stored in a browser application installed in the client computer and comprises a user selected bookmark address for quick retrieval". It is not clear how

server repeatedly receiving in a predetermined time interval. It is also not clear how the browser is enabled to send repeatedly, a user-selected, bookmark addresses to server.

12. Claims 1, 6, and 20 recites the limitation "the client" in line 6. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 9 recites the limitation "the appliance" in line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Regarding claim 20, the phrase "adapted to" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2100.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 3-7, 9, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. (2002/0078102) (hereinafter Dutta) in view of Ryu M Et al. (6,775,291) (hereinafter Ryu).

17. As per claim 1, Dutta discloses a method for providing access to network path bookmark information for a mobile device, the network path bookmark information being stored in a client computer (fig 4A-4C, col, paragraph #0029; #0032), said method comprising:

repeatedly receiving (paragraph #0052 and #0055, client pushes the bookmarks to server), at a server (Paragraph #0052) via a first communication network (paragraph #0052 and #0055, client pushes the bookmarks to server), the network path bookmark information from the client (Paragraph #0052), computer, wherein the network path bookmark information is stored in a browser application installed in the client computer (paragraph #0029) and comprises a user selected bookmark address for quick retrieval (paragraph #0029; #0052);

receiving at a server computer via a second communication network, a request for a bookmark name corresponding to the user-selected bookmark address from a mobile device (paragraph #0006, #0022); and

transmitting, from the server computer (paragraph, #0006-#0007), the bookmark name to the mobile device (paragraph, #0006-#0007), the bookmark name allowing the mobile device access to the network path bookmark information (paragraph, #0006-#0007).

Dutta does not explicitly disclose repeatedly receiving in a predefined time interval via a first communication network, requests a bookmark name corresponding to the bookmark address, and the server computer transmits the bookmark name to the mobile device the bookmark allowing the mobile device access to the network path bookmark information. However, Ryu discloses repeatedly receiving in a predefined time interval via a first communication network (calculating Time to Live is repeated process to update the URL in a client process, Col 2, lines 58-64; col 5, lines 45-55; col 8, lines 1-23), requests a bookmark name corresponding to the bookmark address, and the server computer transmits the bookmark name to the mobile device the bookmark allowing the mobile device access to the network path bookmark information (Col 2, lines 58-64; col 8, lines 1-23; col 8, lines 1-23). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Dutta

and Ryu. The motivation would have been remotely printing, copying, and/or faxing documents from the mobile devices via internet using URL (bookmark) stored in a central repository by the user.

18. As per claim 3, the claim is rejected for the same reasons as claim 1, above. In addition Dutta discloses the wherein the network path bookmark information is stored in a predetermined directory in the client computer (214, fig 2, paragraph #0029).

19. As per claim 4, the claim is rejected for the same reasons as claim 1, above. In addition Dutta discloses the browser application is an internet browser application program (204, fig 2, paragraph #0029).

20. As per claim 5, the claim is rejected for the same reasons as claim 1, above. In addition Dutta discloses transmitting from the server computer a request for access to the network path bookmark information to the client upon receiving at the server the request from the mobile device (332, fig 2; paragraph, #0006-#0007; #0052).

21. As per claim 7, the claim is rejected for the same reasons as claim 1, above. In addition Dutta discloses the network path bookmark information is

encoded according to the HTML format or according to the WML format (paragraph #0006-#0007; #0022; #0026).

22. As per claim 9, the claim is rejected for the same reasons as claim 1, above. In addition Dutta discloses wherein the user-selected bookmark address designates a remotely stored information to be processed the determined network path bookmark information of the remotely stored information to be processed and the appliance to which the information (paragraph #0006-#0007; #0022; #0026) which is connected to the network path bookmark information (col 5, lines 14-28), is to be applied as instructions in the mobile device (paragraph #0006-#0007; #0022; #0026), transmitting the instructions from the mobile device to a first computer system via a third communication network (paragraph #0006-#0007; #0022; #0026), the first computer system retrieving the remotely stored information based on the instruction and converting the information to a format suitable for the appliance (bookmark, paragraph #0006-#0007; #0022; #0026; 0039); and

the first computer system supplying the remotely stored information to the appliance processing according to the instruction (bookmark, paragraph #0006-#0007; #0022; #0026; 0039).

23. As per claim 12, the claim is rejected for the same reasons as claims 9 and 4, above. In addition, Ryu discloses wherein the first computer system is an appliance server computer (fig 4, col 5, lines 14-36).

24. As per claim 13, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses a plurality of appliances are connected to the first computer system, and the appliance is among said plurality of appliances in the instructions (fig 4, col 5, lines 14-36).

25. As per claim 14, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses plurality of appliances are registered in the first computer system (network manage sub system, col 5, lines 14-46).

26. As per claim 15, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses the appliance is designated based on the client computer's identity in the instructions (network manage sub system, col 5, lines 14-46).

27. As per claim 16, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses the third communication network includes a gateway (13, fig 1) using standard telecommunication protocols (col 1, line

40 to col 2, line 34), and the gateway converts the instructions to a format, which the first computer system understands (col 1, line 40 to col 2, line 34).

28. As per claim 17, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses the remotely located information is stored in a second computer system from which the first computer system retrieves the remotely located information according to the instructions (col 5, lines 14-46).

29. As per claim 18, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses wherein the appliance is a printer, and the first computer system converts the remotely located information to a print job in a format suitable for printing (gateway fig 1, col 5, lines 14-46).

30. As per claim 19, the claim is rejected for the same reasons as claim 9, above. In addition Ryu discloses the first computer system converts the remotely located information to a PDL format for printing page (col 1, line 40 to col 2, line 34).

31. As per claim 6, the claim is rejected for the same reasons as claim 1, above. In addition, Ryu discloses receiving a request from the mobile device for access to the network path bookmark information wherein the network path bookmark information is stored in a browser application installed in the client computer comprises a user-selected bookmark address for quick retrieval (col 6, lines 26-41);

determining whether the requested network path bookmark information is already stored in the server computer (col 6, lines 42-67);

upon determining that the requested network path bookmark information is not (col 6, lines 42-44) already stored transmitting a request for the network path bookmark information to the client (col 6, lines 25-67),

receiving the requested network path bookmark information from the client computer (col 6, lines 26-67); and

once the requested network path bookmark information is received (col 6, lines 26-41), transmitting the requested network path bookmark information to the mobile device in response to the request from the mobile device (col 6, line 26 -41).

32. As per claim 20 the claim is rejected for the same reasons as claim 1, above.

Response to Arguments

33. Applicant's arguments with respect to claims 1, 3-7, 9, and 12-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Paten 6,032,162 teaches processing and storing bookmark addresses.

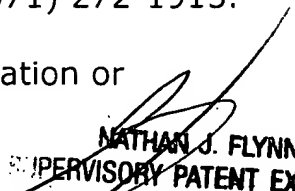
U.S. Paten 6,560,640 teaches remote bookmarking for client devices.

U.S. Patent 6,427,175

U.S. Patent 6,766,363

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

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MAS